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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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08/817,704

08/25/97

SWAAK

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P8214-7002

HM22/0327  
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EXAMINER

VANDER VEGT, F

ART UNIT

PAPER NUMBER

1644

18

DATE MAILED:

03/27/00

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

# Office Action Summary

Application No.  
**08/817,704**

Applicant(s)  
**Swagak**

Examiner  
**F. Pierre VanderVegt**

Group Art Unit  
**1644**



☒ Responsive to communication(s) filed on Jan 28, 2000

☒ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire three month(s), ~~or thirty days, whichever is longer~~, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

## Disposition of Claims

☒ Claim(s) 14-26, 30, and 31 ~~is~~ are pending in the application.

Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

☐ Claim(s) \_\_\_\_\_ is/are allowed.

☒ Claim(s) 14-26, 30, and 31 ~~is~~ are rejected.

☐ Claim(s) \_\_\_\_\_ is/are objected to.

☐ Claims \_\_\_\_\_ are subject to restriction or election requirement.

## Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

### DETAILED ACTION

This application is a rule 371 continuation of PCT/NL95/00370. Applicant should amend page 1 of the specification to reflect the priority information.

New claims 30 and 31 have been added.

Claims 14-26 and 30-31 are currently pending in this application.

1. The Examiner in charge of your application in the PTO has changed. To aid in correlating any papers for this application, all further correspondence regarding this application should be directed to Examiner F. Pierre VanderVegt of Group Art Unit 1644.
2. Applicant's arguments filed January 28, 2000 with respect to claims 14-26 have been considered but are moot in view of the new ground(s) of rejection.
3. **The following new grounds of rejection are necessitated by Applicant's amendment.**

#### *Claim Rejections - 35 U.S.C. § 112*

4. Claims 14-26 and 30-31 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

The newly added limitation of the amendment filed January 28, 2000 to claim 14 which recites "wherein the patient does not have anemia of chronic disease or rheumatoid arthritis" was not disclosed in the claims or specification as originally filed and constitutes new matter. The negative limitation is not supported by any statement in the specification suggesting such a limitation for practice of the invention and was added merely in an attempt to differentiate the invention from the prior art of record. See *Ex parte Grasselli*, 231 U.S.P.Q. 393, 394 (PTO Bd. App. 1983).

Read in the alternative, where the recitation of "or" separates two clinical conditions, the newly added limitation of the amendment filed January 28, 2000 to claim 14 which recites

"wherein the patient does not have anemia of chronic disease or rheumatoid arthritis" was not disclosed in the claims or specification as originally filed and constitutes new matter. The instant specification teaches the treatment of patients with rheumatoid arthritis with erythropoietin to alleviate symptoms. At no point do the claims or specification as originally filed disclose or suggest a limitation excluding patients with anemia of chronic disease or patients with rheumatoid arthritis.

The recitation of "period is at least 3 weeks" newly added limitation in the amendment filed January 28, 2000 to base claims 18 and 20 was not disclosed in the claims or specification as originally filed and constitutes new matter. While the specification discloses particular effects of the method being notable at the 3 week timepoint, there is no disclosure or suggestion in the claims or specification as originally filed of a limitation of the invention wherein the method is performed for a period of at least 3 weeks, only of 6 weeks.

The recitation of the limitation "period is at least 6 weeks" in newly added claims 30 and 31 of the amendment filed January 28, 2000 was not disclosed in the claims or specification as originally filed and constitutes new matter. The specification only discloses in Table II "the 6 week therapy and after 3 and 6 weeks of treatment." Therefore, the instant specification as originally filed discloses only a 6 week therapeutic period, not "at least 6 weeks" and the language therefore broadens the scope of the claim beyond that which is actually disclosed. There is no disclosure or suggestion in the claims or specification as originally filed of a limitation of the invention wherein the method is performed for a period of "at least" 6 weeks, only of 6 weeks.

### *Conclusion*

5. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after

the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

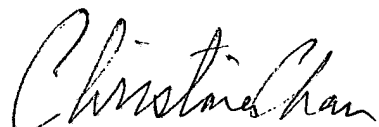
6. The specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which Applicant may become aware in the specification.

7. Papers related to this application may be submitted to Technology Center 1600, Group 1640 by facsimile transmission. Papers should be faxed to Group 1640 via the PTO Fax Center located in Crystal Mall 1. The faxing of such papers must conform with the notice published in the Official Gazette, 1096 OG 30 (November 15, 1989). The fax phone number for official documents to be entered into the record for Art Unit 1644 is (703)305-3014.

Any inquiry concerning this communication or earlier communications from the Examiner should be directed to F. Pierre VanderVegt, whose telephone number is (703)305-6997. The Examiner can normally be reached Tuesday through Friday and odd-numbered Mondays (on year 2000 366-day calender) from 6:30 am to 4:00 pm ET. A message may be left on the Examiner's voice mail service. If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Ms. Christina Chan can be reached at (703)308-3973. Any inquiry of a general nature or relating to the status of this application should be directed to the Technology Center 1600 receptionist, whose telephone number is (703)308-0196.



F. Pierre VanderVegt, Ph.D.  
Patent Examiner  
Technology Center 1600  
March 22, 2000



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GROUP 1800-1660